

REMARKS

Claims 1-21 and 41-59 are pending. By this Amendment, Claims 1, 3, 9, 46, 58, and 59 are amended, thereby leaving Claims 2, 4-8, 10-21, 41-45, and 47-57 unchanged.

Applicants wish to thank the Examiner for the indication of allowable subject matter in Claim 58. Applicants have amended Claim 58 into independent form to include its base claim and any intervening claims. Accordingly, independent Claim 58 is allowable.

Drawings

The drawings stand objected to under 37 CFR §1.83(a) as not showing every feature of the invention specified in the claims. Particularly, the Examiner indicates that the following claim language is not shown in the drawings: 1) upright and inverted orientations with the shield below and above the air outlet (Claim 21); 2) the first and second radial widths (Claims 9 and 46); and 3) the flexible shield (Claim 58).

Applicant respectfully disagrees with the drawing objections and believes that the subject matter of the claims is supported by the drawings and the description.

1) Regarding the language of Claim 21, the router is clearly shown in the upright orientation in Figs. 1 and 3-8 and is clearly shown in the inverted orientation in Figs. 2, 17, 18, 20, 21, 26, 27, and 32. One of ordinary skill in the art of routers understands how the router is oriented relative to a workpiece when in an upright orientation and an inverted orientation. Also, at least Figs. 11-24, 26, 27, and 32 show the orientation of the shield within the router and particularly with respect to the outlet. Figs. 11-24, 26, 27, and 32 are bottom or bottom perspective views showing the shield and other portions of the router. These bottom and bottom perspective views are similar to the inverted orientation, in which the base is below a workpiece. In these figures, the shield is clearly shown above the air outlet. With this understanding of the inverted orientation of the shield relative to the air outlet, one of ordinary skill in the art of routers, or those who read the description and reference the figures of the present application, would be able to easily understand that the shield is oriented below the air outlet when the router is in the upright orientation. Accordingly, the objection to the drawings in view of Claim 21 is improper and Applicant respectfully requests withdrawal of this objection.

2) Regarding the language relating to Claims 9 and 46, Claims 9 and 46 have been amended to more clearly define the claimed subject matter thereof. The language of Claims 9

and 46 is clearly shown and supported in the figures. The first radial width is shown and supported in Figs. 12 and 17 (among other places) and the second radial width is shown and supported in Figs. 13-21 (among other places). One of ordinary skill in the art of routers would agree that the subject matter of Claims 9 and 46 is shown and supported in the drawings. No new matter is added.

3) Regarding the "flexible shield" language in Claim 58, the flexible shield is clearly shown in Figs. 25-32 and described on page 11, line 12 through page 12, line 3. One of ordinary skill in the art of routers would agree that the subject matter of Claim 58 is shown in the drawings.

In view of the comments presented above, withdrawal of the drawing objections is respectfully requested. Accordingly, no corrected drawings are required.

35 USC § 112, first paragraph, Rejections

Claims 21 and 56 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. Particularly, the Examiner indicates that the claims contain subject matter that was not described in the specification in such a way as to enable one skilled in the art of routers to make and use the invention.

Applicants respectfully disagree with these rejections of Claims 21 and 56. Reference is made to the Drawings section above and particularly to number (1) of the Drawings section where Claim 21 is addressed. The comments above relating to Claim 21 similarly relate to Claim 56 because Claim 56 discloses generally similar subject matter to Claim 21. In addition to the comments above, one of ordinary skill in the art would clearly be able to make and use the router as defined in Claims 21 and 56 in view of Figs. 1 and 2 (and others) showing the upright and inverted orientations of the router, Figs. 11-24, 26, 27, and 32 show the orientation of the shield within the router, and page 10, lines 5-16 of the specification describing the shield.

For these and other reasons, Claims 21 and 56 satisfy 35 USC § 112 and withdrawal of the rejections is respectfully requested.

35 USC § 102 Rejections

Claims 1-9, 11-15, 18, 41-46, 49, 50-52, 55, 57, and 59 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 4,051,880 ("Hestily").

Currently amended independent Claim 1 recites:

A power tool comprising: a motor; a motor housing supporting the motor and defining an air outlet and an air flow path from the motor housing through the air outlet; and a shield removably connectable to the motor housing, the shield being positionable at least partially outside the motor housing and to at least partially cover the air outlet.

Hestily discloses a router 10 including a base 12, a pair of handles 30, 32 connected to the base 12, a motor housing 36, a motor 42 connected to the motor housing 35 and including an armature shaft 46, and a fan 52 affixed to the armature shaft 46 for providing ventilation for the motor 42 by drawing air through apertures 54 and passage way 56 formed adjacent an upper end of the motor housing 36 (Col. 1, ln. 61 – Col. 2, ln. 32). The router 10 also includes a blower 82 connected to a top of the router 10. The blower 82 includes an inlet conduit 80, which introduces the flow from the router to a rotor 84. The blower 82 also includes an end cap 88 positioned on top of the router 10 and surrounding the rotor 84.

Hestily does not teach or suggest the subject matter of independent Claim 1. More particularly, Hestily does not teach or suggest, among other things, a motor housing defining an air outlet and a shield removably connectable to the motor housing, the shield being positionable at least partially outside the motor housing and to at least partially cover the air outlet. Rather, Hestily discloses a router 10 including an exhaust or outlet aperture 58, through which air exhausts from the motor housing, that is open and uncovered, and a blower positioned on the top of the router, displaced significantly from the outlet aperture 58. There is no disclosure within Hestily that discloses a shield removably connectable to the motor housing and at least partially covers the outlet opening as defined in Claim 1.

The Examiner attempts to rely on end cap 88 to represent the shield as claimed in Claim 1. However, the end cap 88 is not a shield and does not at least partially cover an outlet opening that is defined by the motor housing. The end cap 88 may cover or at least partially cover some portion of the blower 82 cavity, but the end cap 88 does not cover an outlet opening defined in the motor housing. In addition, Hestily actually teaches away from any portion of the blower 82 defining the outlet opening and covering such an opening. More particularly, Hestily cites an inlet conduit 80 between the router 10 and the blower to introduce air flow from the router to the blower. The fact that a device (inlet conduit 80) is introduced between a first component (the router 10) and a second component (the blower 82) to transfer air flow from one to another

illustrates that the second component cannot be considered part of the first component, and accordingly, the second component must be considered its own component and cannot include any of the elements of the first component. Relating to the present case, the blower and router are separate components and the inlet conduit transfers air flow from the router to the blower. Accordingly, the outlet opening must be defined by the motor housing of the router and cannot be identified as some component of the blower, as was attempted by the Examiner. The Examiners attempt to utilize the end cap 88 as a shield and some other portion of the blower to represent the air outlet is improper.

For these and other reasons, Hestily does not teach or suggest the subject matter of independent Claim 1. Accordingly, independent Claim 1 is allowable. Claims 2, 41-57, and 59 depend from independent Claim 1 and are allowable for the same and other reasons as Claim 1.

Currently Amended independent Claim 3 recites:

A router comprising:
a base;
a motor housing supported by the base and defining a central axis
and an air outlet, the air outlet having portions thereof positioned on each of two
opposing sides of the central axis, air passing from the motor housing through the
air outlet;
a motor supported by the motor housing; and
a shield connectable to the motor housing in a position to at least
partially cover the portions of the air outlet on the two opposing sides of the
central axis.

Hestily does not teach or suggest the subject matter of Claim 3. More particularly, Hestily does not teach or suggest, among other things, an air outlet having portions thereof positioned on each of two opposing sides of a central axis of the motor housing and a shield connectable to the motor housing in a position to at least partially cover the portions of the air outlet on the two opposing sides of the central axis. Rather, Hestily discloses an exhaust or outlet aperture 58 defined in the motor housing 36 that is positioned on one side of a central axis of the motor housing (see Fig. 1) and the aperture 58 being uncovered. Hestily has no disclosure therein of a shield and more particularly has no disclosure of a shield that is positionable to at least partially cover portions of an air outlet on two opposing sides of a central axis of the motor housing 36.

For these and other reasons, Hestily does not teach or suggest the subject matter of independent Claim 3. Accordingly, independent Claim 3 is allowable. Claims 4-21 depend from independent Claim 3 and are allowable for the same and other reasons.

35 USC § 103 Rejections

Claims 10, 11, 16, 47, 48, and 53 stand rejected under 35 USC § 103(a) as being unpatentable over Hestily alone.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference(s) or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§706.02(j), 2143.03.

Because the Examiner only relied upon Hestily for this rejection, the first and second criteria do not apply. However, the third criteria still applies. Accordingly, Hestily must teach or suggest all the claim limitations of Claims 10, 11, 16, 47, 48, and 53. As the Examiner concedes in the Office action, Hestily does not disclose all the claim limitations of Claims 10, 11, 16, 47, 48, and 53. Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of Claims 10, 11, 16, 47, 48, and 53.

The Examiner attempts to provide the missing claim limitations of Claims 10, 11, 16, 47, 48, and 53 by stating that it would be obvious to arrive at the undisclosed claim limitations, without providing any evidentiary support. Deficiencies of references cannot be saved by appeals to "common sense" and "basic knowledge" without any evidentiary support. *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001). Accordingly, the Examiner's leap to identify the undisclosed subject matter of Claims 10, 11, 16, 47, 48, and 53 as being obvious is improper.

In addition, the Examiner states that the undisclosed subject matter of Claims 10, 11, 16, 47, 48, and 53 does not itself impart patentability because the subject matter is a result of discovering an optimum value of a result involving only routine skill in the art. Applicants respectfully submit that the undisclosed subject matter is not a result of determining an optimum value and that the Examiner's interpretation of the undisclosed subject matter of Claims 10, 11, 16, 47, 48, and 53 is improper. Applicants believe that the Examiner's presentation of this

reasoning is provided only as a substitute for the lack of findings in Hestily and that the only motivation for the subject matter of Claims 10, 11, 16, 47, 48, and 53 that is not disclosed in Hestily comes from Applicants' invention, and, therefore, the Examiner's rejection is a classic case of hindsight.

For these and other reasons, Hestily does not teach, suggest, or make obvious the subject matter of Claims 10, 11, 16, 47, 48, and 53. Accordingly, Claims 10, 11, 16, 47, 48, and 53 are allowable.

Further, Claims 10, 11, 16, 47, 48, and 53 respectfully depend from one of independent Claims 1 or 3 and are allowable for the same and other reasons as their respective independent claim.

Claims 17 and 54 stand rejected under 35 USC § 103(a) as being unpatentable over Hestily in view of U.S. Patent No. 6,488,455 ("Staebler"). Claims 17 and 54 respectfully depend from independent Claims 1 or 3 and are allowable for the same and other reasons as their respective independent claim.

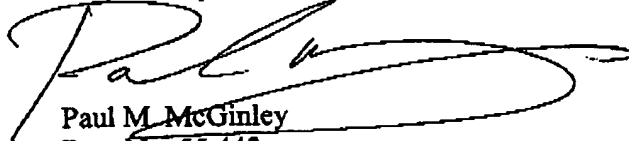
Claims 19 and 20 stand rejected under 35 USC § 103(a) as being unpatentable over Hestily in view of U.S. Patent No. 5,310,296 ("McCurry"). Claims 19 and 20 depend from independent Claims 3 and are allowable for the same and other reasons.

CONCLUSION

In view of the foregoing, entry of the present Amendment and allowance of Claims 1-21 and 41-59 are respectfully requested.

The undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,



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